



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,293	05/04/2001	Angelica Golubkov	2605.30	1865

5514 7590 03/07/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 03/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,293

Applicant(s)

GOLUBKOV ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The present of the narrow and broad limitation for the " ≥ 98 % of the total volume of the motor fuel for component (iv) in claim 11 (and its dependent claims 12-13) is indefinite.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 11 recites the broad recitation (iv) ≥ 98 % of the total volume of the motor fuel composition distills at

Art Unit: 1714

temperature no higher than 400° C, and the claim also recites suit no higher than 370° C; and preferably no higher than 280° C which is the narrower statement of the range/limitation.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 11-30 are rejected under 35 U.S.C. 102(b) as being clearly by Killick et al (Killick) WO 95/02654

Killick teaches a fuel composition comprising diesel oil, ethanol, methanol, ethyl oleate and butyl benzoate that anticipates the instant claims 1-8 and 11-29, composition 9 on page 6 and page 11, lines 24-34. Patent further teaches a method for preparing the fuel composition, page 3 lines 18-33 that anticipates instant claim 30. Killick teaches a method for introducing a fuel composition to a combustion engine, page 11 lines 6-23 that anticipates instant claim 31. With respect to claims 11-13, 17-18, 28 and 29 it is the examiner's position that the instant claimed properties would be inherently present in the composition of Killick having the same components as those of the instant claimed. With respect to instant claims 15-16 the further components would inherently be present as by-products during the production of the said compound. The water component of claim 19 would inherently be present as a contaminant.

Claims 1-9 and 11-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Majunke et al (Majunke) EP 0,121,089A2.

Art Unit: 1714

Majunke teaches a method for producing a fuel composition, a method for adding said composition to a combustion engine and a fuel composition comprising a bio-ethanol, tert-butanol, acetone and methyl-tert-butylether, examples 4, wherein the said bio-ethanol comprises aldehyde, ketone, ethyl acetate, and water, page 3 lines 16-25 that anticipates the instant claims. See also the English abstract of EP 0121,089 and The EP 0,21,089 B1 copy of the said reference.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sweeney.

Sweeney teaches a method for preparing and method for adding a fuel composition to a engine and a fuel composition comprising diesel fuel and a product ether-alcohol liquid comprising a mixture of ethers and a mixture of alcohols and the presence of a small amount of water, column 6 lines 49-6, column 5, lines 45-58 and Example II of page 7 lines 19-48 that anticipates the instant claims.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham 5,405,417

Cunningham teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, column 2, lines 23-46, peroxy esters, column 3, lines 25-41 and one or more organic nitrate esters, column 3, line 43 to column 4, lines 1-4 that anticipates the instant claims. The nitrate compounds and the peroxy esters contain more than one functional group.

Claims 1-8 and 11-31 rejected are under 35 U.S.C. 102(b) as being anticipated by Bowers et al (Bowers) 4,892,562.

Bowers teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel a Pd acetyl acetate, and an oxygenated solvent that that may be a mixture of tetrahydrofuran, methyltertiary butyl ethyl ether and octyl nitrate, column 7 for Table 1 A, Examples B-D of Table 6 of column 13 and claims 1 and 8 that anticipates the instant claims.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Darin et al (Darin) 4,746,420

Darin teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, a mixture of primary solvent and a mixture of co-solvents prior to the separation step that anticipates the instant claims, column 7 line 31-to column 9 line15.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Purcell et al (Purcell) 4,549,883.

Purcell teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel and cetane improver or mixtures thereof, column 2 line 37-40 including the 5-methyl-5-nitro-3-oxo-henanol of example 3 of column 6 that anticipates the instant claims.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Seemuth.

Seemuth teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, an alcohol and

Art Unit: 1714

tetrahydro-2-5-furandimethanol dinitrate, column 3 and claim 1 that anticipates the instant claims.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Seemuth 4,536,190.

Seemuth teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, nitro nitrate and ketone nitrate that anticipates the instant claims, abstract, column 3 line 40 column 4 line 66.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lozzi 5,766,272.

Lozzi teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, dimethylcarbonate, aldehyde and ethyl nitrate that anticipates the instant claims, abstract, column 1, line 52 to column 2 line 67 and claims 1-9.

Claim 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baker US 4,509,950 and GB 2,115,002 A.

Baker teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, block or graft copolymer with several oxygenated functional groups and salt of an aliphatic amino compound with long-chain aliphatic carboxylic acid that anticipates the instant claims, abstract, tables 1-2 and examples 1-9.

Claims 1-8 and 11-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oppenlaender et al EP 014,992.

Oppenlaender teaches a method for producing and a method for adding a fuel composition to an engine and a fuel composition comprising a fuel, polyethers, acetals, ethanol and methanol that anticipates the instant claims, abstractpage2 line 20 to page 4 line and Table 5.

The examiner takes the position that the claims are so broad and read on numerous compounds those disclose and those that are not disclosed that the claims are anticipated by the prior art relied on above. The examiner takes the position that the hydrocarbon component is an optional component and is not required in the claims as drafted.

Claim 10 appear to contain allowable subject matter.

The prior art made of record by applicant in Paper No. 4 dated September 5, 2001 has been reviewed and made of record.

The prior art cited but not relied upon further teaches fuel compositions comprising additives of the same nature as that of the instant claims.

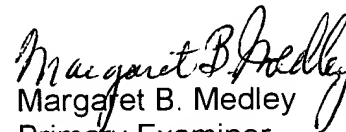
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

Art Unit: 1714

872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
Art Unit 1714

Margaret B. Medley
March 5, 2003